

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST M. FAIGLE,
JOHN H. SEMCHENA
and
RICHARD J. THOMPSON

Appeal No. 95-2803
Application 08/024,851¹

ON BRIEF

Before CALVERT, COHEN and FRANKFORT, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 26, 1993. According to appellants, the application is a continuation of Application 07/719,322, filed June 21, 1991, abandoned.

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This is an appeal from the final rejection of claims 29, 30, and 33. Claim 19, the only other claim remaining in the application, stands allowed.

Appellants' invention pertains to a cylindrical inflator for inflating a vehicle occupant restraint. An understanding of the invention can be derived from a reading of exemplary claim 29, a copy of which appears in the "Appendix" to appellants' brief (Paper No. 26).

The following rejection is the sole rejection before us for review on appeal.²

Claims 29, 30, and 33 stand rejected under 35 U.S.C. § 101 (double patenting) as claiming the same invention as that of claims 1 through 3 and 5 through 10 of commonly-assigned prior U.S. Patent No. 5,248,162 to Levosinski et al. (Levosinski).

² A final rejection of claims 31 through 33 under 35 U.S.C. § 103 was not repeated in the answer. We note that claims 31 and 32 were canceled pursuant to the entered amendment after final dated September 12, 1994 (Paper No 22), and that on page 4 of the answer (Paper No. 27) the examiner indicated that, upon reconsideration, claim 33 was considered to be allowable over applied art.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the final rejection and answer (Paper Nos. 21 and 27), while the complete statement of appellants' argument can be found in the brief (Paper No. 26).³

OPINION

³ The final rejection and examiner's answer only specify a "same invention" double patenting rejection. Appellants have interpreted language in the Advisory Action of September 23, 1994 (Paper No. 23) as reflecting that the examiner has withdrawn the "same invention" double patenting rejection and substituted therefor a rejection for obviousness type double patenting. With this understanding, appellants present arguments addressed to both "same invention" and "obviousness type" double patenting. We disagree with appellants' above perception. As the examiner's answer reveals (page 3) only a "same invention" double patenting rejection is specified by the examiner. An "obviousness type" double patenting rejection is not set forth in the final rejection or answer. While the examiner may have commented upon the pending claims as being broader than the patented claims in the aforementioned Advisory Action, this viewpoint, when considered with the examiner's listing of only a "same invention" double patenting rejection in the answer, makes it clear to us that the examiner did not intend and has not added an "obviousness type" double patenting rejection to the record. For this reason, we need not address appellants' arguments directed towards an obviousness type double patenting issue (brief, pages 5 through 9). As a concluding point, we simply note In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) as a case addressing the circumstance of broad claims of one patent dominating another patent's narrower claims.

In reaching our conclusion on the "same invention" double patenting issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims 29, 30 and 33,⁴ the rejection under 35 U.S.C. § 101, the claimed subject matter of U.S. Patent No. 5,248,162, and the respective viewpoints of appellants and the examiner.⁵ As a consequence of our review, we make the determination which follows.

⁴ The term "Apparatus" in claim 30, line 1, should more appropriately be --A cylindrical inflator--, for consistency with parent claim 29.

⁵ Each of appellants' specification (pages 1 through 3) and the Levosinski specification (column 1, lines 10 through 46) refers to the earlier U.S. Patent No. 4,846,368 to Goetz, of record in the present application, as background for the respective inventions. However, the inventions differ from one another. The Levosinski patent seeks to retain the cylindrical housing and pressure controlling layer of foil of Goetz, but includes a plenum member in the form of a strand wound in a helix, in place of the plenum mesh screen of Goetz. On the other hand, in the pending application, the cylindrical housing structure (with plenum mesh screen and pressure controlling layer of foil) of Goetz is eliminated and replaced with a pair of end caps having an outer filter layer and ends of a helically wound strand extending thereover, characterized by appellants (specification, page 2) as a "simplified structure."

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We reverse the rejection of appellants' claims under 35 U.S.C. § 101.

In a statutory double patenting rejection under 35 U.S.C. § 101, the issue is whether the same invention is being claimed twice. Same invention means IDENTICAL subject matter.

As expressed by the court in In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970):

A good test, and probably the only objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other.

In the present case, we find that the test can be responded to in the affirmative, reflecting that the pending claims and the patented claims to Levosinski do not address the same invention.

The examiner's view is that claims 29 through 33 in the present application are drawn to the same invention as that of claims 1 through 3 and 5 through 10 of the U.S. Patent No. 5,248,162.

Independent claims 29 and 33 are drawn to a cylindrical inflator per se. Claim 29 requires, inter alia, an ignitable gas generating material, and a cylindrical tube extending axially between a pair of circular side walls. Claim 33 requires, inter alia, an ignitable gas generating material and tubular means⁶ for containing the gas generating material comprising filter means for filtering gas.

Patent claims 1 through 3 are drawn to an apparatus which comprises, inter alia, a source of gas, a filter, a pressure controlling member, and a single continuous piece of wire of thickness substantially equal to the distance between the filter and pressure controlling member, while patent claims 5 through 10 set forth an apparatus comprising, inter alia, an inflatable vehicle occupant restraint, a source of gas, a cylindrical wall member, a pressure controlling member, filter means and a strand with a thickness substantially equal to the

⁶ Consistent with appellants' underlying disclosure, we understand the recited tubular means (35 U.S.C. § 112, sixth paragraph) as corresponding to the structure described in the specification (central tube 50 and filter layers 60) and equivalents thereof.

distance between the filter means and the pressure controlling member.

Comparing the pending independent claims 29 and 33 with the aforementioned patent claims, it is clear that the former pending claims do not require the pressure controlling member (and a strand with a thickness substantially equal to the distance between a filter or filter means and the pressure controlling member) of the latter patent claims. Accordingly, and

consistent with the argument advanced by appellants (brief, pages 4 and 5), a cylindrical inflator with the features of claims 29 and 33, and without a pressure controlling member, would infringe claims 29 and 33 but would clearly not infringe independent patented claims 1, 5, and 8. For the above reasons, the pending claims are not seen to be for the same invention claimed in U.S. Patent No. 5,248,162.

In summary, this panel of the board has reversed the rejection of appellants' claims 29, 30, and 33 under 35 U.S.C. § 101.

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The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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